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10/645,153

08/21/2003

Michael Delaney

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10/16/2009

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EXAMINER

DEODHAR, OMKAR A

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

10/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/645,153 | Applicant(s) DELANEY ET AL. | |
| | Examiner OMKAR A. DEODHAR | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Non-Final Rejection

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6 & 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite "wherein play of the bonus game does not require an additional wager." There does not appear to be support for this limitation. Appropriate correction and/or clarification is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7 & 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite a "Class III style game". This is indefinite because what constitutes Class III gaming may change. It is also indefinite

because Applicant has not adequately described what constitutes "style". Appropriate correction and/or clarification is required.

Claim Objections

Claims 3 & 8 recite "...a selectable indicia...being selected." This should recite "...a selectable indicium...being selected." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (US 5,324,035) in view of Vancura (U.S. 6,609,971).

Claims 1, 2, 6, 7, 11, 12: Morris discloses a gaming system comprising a central server configured to generate game results using fixed-pools of elements derived from a Class III style game & a player terminal in communication with the central server, configured to send game play requests to the central server and receive game play results from the central server.

(Morris discloses a gaming system with a fixed pool of game plays and a predetermined number of winning plays within each pool. (Abstract). A central processor communicates with master processing units and supplies various games available for play. (Abstract). Master processing units administer games as they are played on slave gaming terminals. (Abstract). Each player, through his slave terminal, purchases plays in each fixed pool. (Abstract). Morris discloses that his system simulates, through a video game embodiment, the action and play of a paper pull-tab

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lottery {Class II} game. (Col. 5. Lines 33-35). Morris additionally discloses that his gaming system supplies a variety of games including blackjack & slot machine {Class III} games. (Col. 5. Lines 35-40).

Morris does not disclose that each fixed pool element corresponds to a single game play result divisible into a base game play result and a bonus game play result, wherein play of the bonus game does not require an additional wager.

In a related invention, Vancura teaches a five-reel slot machine base game and a pick or selection type bonus game. (Vancura, Col. 2. Lines 45-62, Figure 2, Col. 3. Lines 5-12). Vancura additionally teaches that it is well-known in the art for bonus games to be provided without requiring additional wagers. (Vancura Col. 1. Lines 10-18). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide a base slot reel game & a bonus pick game (without requiring an additional wager), as taught by Vancura, in Morris' Class III slot machine game simulating a Class II game. Morris' disclosure makes it clear that his system is amenable to simulating a Class III game using the results of a Class II fixed pool lottery. The modification would work just as one would expect it to & it yields the predictable results of providing a Class III gaming experience in jurisdictions where only Class I or II gaming is permitted.

Regarding the following claim limitations: "the player terminal further configured to determine a base game play result and a bonus game play result from a single game play result received from the central server, to reverse-map the base game play result into a display such that the display simulates a Class III style game by showing game

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indicia having a value corresponding to the base game play result, and further shows bonus game indicia, different from the base game play display, having a value corresponding to the bonus game play result, wherein the single game play result is a fixed sum that is awarded to the player,”

These limitations inherently follow from implementing Vancura's slot reel base game & bonus pick game in Morris' system because, Morris' fixed pool result simulated on his slot machine would represent the result from Vancura's base game & a payout, if any, from Vancura's bonus game. And, this requires reverse-mapping the fixed pool result into a Class III representation. At conclusion of the bonus game, the fixed pool game result would be displayed & awarded to the player. During the base & bonus games, indicia would be displayed on the slot machine. Vancura's bonus pick game uses different indicia than his five-reel slot, base game. (See Vancura's Figure 3, showing a number of globes, part of his pick game & different from a reel type game. The globes are a plurality of indicia.)

Claims 3, 8, 13: Morris in view of Vancura teaches wherein the plurality of indicia is selectable, and where the bonus result is divided into a set of partial win results that, in total, are an amount equal to the bonus result, and where the partial win results are awarded one at a time as a result of a selectable indicia being selected, until all of the partial win results are awarded.

See Vancura's Figure 3 showing a plurality of selectable globes (selectable indicia). See Vancura's bonus game flowchart in Figure 2 & note that although one step recites "making a game wager," Vancura teaches that it is known in the art that bonus

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games are provided without requiring additional wagers. (See the rejection of claim 1, where Examiner explained that this renders obvious a bonus game that does not require an additional wager.) As seen in the flowchart steps, a player picks an icon & any hidden attributes are revealed. The game is then "prolonged" by giving the player additional picks. The player is awarded for revealing attributes. This process continues (see arrow 21) & the bonus game is only ended when all picks are used (the player has selected all globes). Every time the player picks an icon & reveals an attribute, a partial win result is achieved. Once every pick has been used, all partial results (if any) are awarded.

Claims 4, 9, 14: Morris in view of Vancura teaches wherein the game play result further includes an indicator recognizable by the player terminal, the indicator indicating that the game play result comprises a base game play result and a bonus game play result. (This inherently follows from implementing Vancura's slot reel base game & bonus pick game in Morris' system for the following reasons: Just as Morris' slave terminals (player terminals) receive (& thereby recognize) the fixed pool games' results, when Morris slot machine is modified to feature Vancura's base & bonus game, the slave terminal would receive an indication that the game result comprises a base game play result & a bonus game play result. The only difference between the result received by Morris' slave terminal & the result received when Morris' system is modified with Vancura is that in the latter case, the game comprises two segments instead of only one.)

Claims 5, 10, 15: Morris in view of Vancura teaches the invention substantially as claimed but does not teach wherein the bonus game play amount is calculated by subtracting a known base game amount from the game play result. It would have been a matter of obvious design choice to a person of ordinary skill in the art at the time of Applicant's invention to calculate the bonus game play amount in this manner -- For instance, if Morris' fixed pool game result was \$10 & the game was simulated on Morris' Class III slot machine, the award realized would be \$10. However, in view of Vancura's two segment game, this award would have to be realized as a single game play result at conclusion of both games. This would require determining how the award would be distributed. Such a determination is viewed as mere design choice that would have obvious to a person of ordinary skill. A person of ordinary skill in the art would surely be able to choose what portion of the \$10 award is to be realized in which game segment. Since this modification is within the level of ordinary skill in the art & not likely to yield any unexpected or unpredictable results, Examiner contends it is obvious.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMKAR A. DEODHAR whose telephone number is (571)272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Corbett Coburn/
Primary Examiner
AU 3714